

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:) Examiner: Salce, Jason P.
)
Rob Myers) Art Unit: 2421
)
Application No. 09/524,770) Confirmation No.: 7597
)
Filed: March 14, 2000)
)
For: A Service Module And A Method)
For Providing A Dedicated On-Site)
<u>Media Service</u>)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group 2421, mailed March 11, 2010, in which claims 16, 18-29, 41, and 42 in the above-identified application were rejected in a final action. This Appeal Brief is hereby submitted pursuant to 37 C.F.R. § 41.37(a).

I. REAL PARTY IN INTEREST

The real parties in interest are the co-assignees of the full interest in the invention: Sony Electronics, Inc., Park Ridge, New Jersey, and Sony Corporation, Tokyo, Japan.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF THE CLAIMS

Claims 16, 18-29, 41, and 42 are pending in the application and were finally rejected in an Office Action mailed March 11, 2010. Claims 32 and 36-40 were subject to a restriction requirement on February 2, 2005 and were subsequently canceled during prosecution. Claims 1-15 and 30-40 were subject of a restriction requirement on September 20, 2006 and were subsequently canceled during prosecution. Claim 17 was canceled during prosecution. Claims 16, 18-29, 41, and 42 are the subject of this appeal. A copy of Claims 16, 18-29, 41, and 42 as they stand on appeal are set forth in Appendix A.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made after receipt of the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's invention as claimed in claims 16, 18-29, and 41-42 is directed to enabling an on-site media service [Specification, page 18, lines 20-22].

Independent method claim 16 claims formatting a media signal with content data and with on-site media service data [Specification, page 11, lines 11-13]. In addition, independent claim 16 claims that the on-site media service data includes a command from an off-site broadcaster that instructs an on-site media system to record the content data without intervention of a user [Specification; page 11, lines 13-17; page 41, lines 1-11]. Furthermore, independent claim 16 claims broadcasting said media signal to an on-site media system having a dedicated tuning device and a dedicated portion of a hard disk for said media signal [Specification; Figure 2, blocks 201 and 203; page 19, lines 2-4; page 22, lines 15-22]. Independent claim 16 further claims that the on-site media service data allows the off-site broadcaster to remotely control a display of an advertisement on said on-site media system, and that the advertisement is enabled in a transition between two programs during a channel changing event [Specification; page 44, lines 14-19]. Independent claim 1 additionally claims that the on-site media service data further

includes metadata that allows the user to locate a specific segment of the content data [Specification, page 8, lines 11-12].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- I. Claims 16, 18-20, 23, 25-26, 28-29, and 41-42 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Hendricks, et al., U.S. Patent No. 5,798,785, Goldschmidt Iki, et al., U.S. Patent No. 6,226,444, Barton, et al., U.S. Patent No. 6,233,389, and Grossman, et al., U.S. Patent No. 5,907,321.
- II. Claims 21-22, 24, and 27 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander et al., U.S. Patent No. 6,177,931.

VII. ARGUMENTS

- I. Claims 16, 18-20, 23, 25-26, 28-29, and 41-42 are Patentable under 35 U.S.C. § 103(a) over Hendricks, Goldschmidt Iki, Barton, and Grossman, because Hendricks, Goldschmidt Iki, Barton, and Grossman do not teach or suggest all elements in the claims.

A. Claims 16, 18-20, 23, 25-26, 28-29, and 41-42 stand or fall together.

Independent claim 16 is the representative claim.

Hendricks discloses a system that delivers television programs to a reprogrammable set top terminal. The terminal presents menus to the viewer suggesting programs to view based on the user's indicated preferences.

Goldschmidt Iki discloses a system controller that records a broadcast program without commercials. The system controller detects the beginning and ending of a commercial in the broadcast program based on data that indicates the start/stop of a commercial in the broadcast program. For example, Goldschmidt Iki discloses a vertical blanking interval (VBI) analyzer that finds data in the VBI of the broadcast program to indicate a commercial starting and ending. Goldschmidt Iki further discloses a graphical user interface that allows user to indicate to the system controller that the broadcasted program should be recorded without commercials.

Barton discloses simultaneously storing and watching different broadcast television programs.

Grossman discloses displaying an image, such as an advertisement, during the time in between channel changes.

In independent claim 16, Appellant claims an on-site media service data that allows the user to locate a specific segment of the content data. Because Hendricks is directed to suggesting entire programs to view and not to locating a specific segment of a program as claimed, Appellant respectfully submits that Hendricks cannot be properly interpreted as teaching or suggesting the claimed element.

With regards to Goldschmidt Iki, the Examiner equates Goldschmidt Iki's VBI data that indicates the start/end of a commercial with Appellant's on-site media data. However, a system controller that uses Goldschmidt Iki's VBI data determines the start/end of a commercial. In contrast, Appellant claims that the user uses the on-site media data to locate a specific segment of the content data. Accordingly, Appellant respectfully submits that this VBI data cannot be properly interpreted as equivalent to Appellant's on-site media data as claimed.

The Examiner further asserts that because Goldschmidt Iki discloses recording a program without the commercials, Goldschmidt Iki necessarily discloses the user locating specific segments in that program. In this assertion, the Examiner appears to argue that Goldschmidt Iki inherently discloses the user locating specific segments (i.e. commercials) in that program. Therefore, the Examiner is equating commercials with specific content segments.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (MPEP § 2112 (IV)).

Appellant respectfully disagrees that Goldschmidt Iki inherently discloses this claim element because the system controller locates the commercials in the program to avoid recording these commercials. Thus, the user cannot locate the commercials because the commercials are no longer part of the recorded program. Therefore, this section of

Goldschmidt Iki discloses the system controller locating commercials, not the user. Accordingly, because the system controller locates the commercials, Applicant respectfully submits that Goldschmidt Iki cannot be properly interpreted as necessarily or inherently disclosing this claim element.

Furthermore, Appellant respectfully submits that there is no other section in Goldschmidt Iki that teaches or suggests an on-site media service data that allows the user to locate a specific segment of the content data as claimed. Therefore, Goldschmidt Iki cannot be properly interpreted as teaching or suggesting this claimed element.

Because Barton is directed to storing and displaying television programs, and does not disclose on-site media service data that allows the user to locate a specific segment of the content data, Barton also cannot be properly interpreted as teaching or suggesting this claimed element.

Grossman is directed to displaying advertisements during channel and, thus, cannot be properly interpreted as teaching or suggesting on-site media service data that allows the user to locate a specific segment of the content data as claimed.

Therefore, Appellant respectfully submits that the combination of Hendricks, Goldschmidt Iki, Barton, and Grossman does not teach or suggest all the elements of claim 16. Accordingly, Appellant respectfully submits that the combination of Hendricks, Goldschmidt Iki, Barton, and Grossman cannot properly be interpreted as rendering obvious Appellant's independent claim 16.

- II. Claims 21-22, 24, and 27 are Patentable under 35 U.S.C. § 103(a) over Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander, because Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander do not teach or suggest all elements in the claims.

A. Claims 21-22, 24, and 27 stand or fall together. Dependent claim 21 depends from claim 16 and is the representative claim.

Alexander discloses an electronic programming guide that provides that ability for the user to select future scheduled television programs to record.

Claim 21 depends on independent claim 16. As per above, the combination of Hendricks, Goldschmidt Iki, Barton, and Grossman does not teach or suggest an on-site

media service data that allows the user to locate a specific segment of the content data as claimed in claim 16. Alexander must do so to render obvious claim 21. However, Alexander discloses the user controlling which programs to record, and does not teach or suggest locating a segment in content using metadata as Appellant claims in claim 16. Thus, Alexander cannot properly be interpreted as teaching or suggesting an on-site media service data that allows the user to locate a specific segment of the content data as claimed. Thus, the combination of Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander cannot be properly interpreted as teaching or suggesting all the elements of claim 21.

Therefore, the combination cannot render obvious Appellant's invention as claimed in claim 21.

VIII. CONCLUSION

Appellant's claims 16, 18-20, 23, 25-26, 28-29, and 41-42 are patentable because the combination of Hendricks, Goldschmidt Iki, Barton, and Grossman does not teach or suggest all the elements of the claims. In addition, Appellant's claims 21-22, 24, and 27 are patentable because the combination of Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander does not teach or suggest all the elements of the claims. Accordingly, Appellant respectfully requests the Board reverse the rejections of claims 16, 18-29, 41, and 42 under 35 U.S.C. § 103(a), and direct the Examiner to enter a Notice of Allowance for claims 1-24.

Fee for Filing a Brief in Support of Appeal

Enclosed is a check in the amount of \$510.00 to cover the fee for filing a brief in support of an appeal as required under 37 C.F.R. §§ 1.17(c) and 41.37(a).

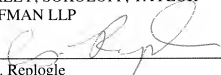
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: July 12, 2010



Eric S. Replogle
Attorney for Appellant
Registration No. 52,161

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being submitted via EFS-WEB
on: July 12, 2010
Assistant: /Carla Anyasia Nascimento/

CLAIMS APPENDIX

1-15. (Canceled)

16. (Previously Presented) A method of enabling an on-site media service, said method comprising:

formatting a media signal with content data and with on-site media service data, wherein the on-site media service data includes a command from an off-site broadcaster that instructs an on-site media system to record the content data without intervention of a user;

broadcasting said media signal to an on-site media system having a dedicated tuning device and a dedicated portion of a hard disk for said media signal, wherein said on-site media service data allows the off-site broadcaster to remotely control a display of an advertisement on said on-site media system and the advertisement is enabled in a transition between two programs during a channel changing event and said on-site media service data further includes metadata that allows the user to locate a specific segment of the content data.

17. (Canceled)

18. (Original) The method recited in Claim 16 wherein said on-site media service data has interactive options that are responsive to a viewer input on said on-site media system.

19. (Previously Presented) The method recited in Claim 16 wherein said on-site media system has a resident-software platform for interfacing information between a broadcaster, a presentation engine, and a viewer.

20. (Previously Presented) The method recited in Claim 16 wherein said media signal is formatted with the metadata on a fine-grain basis for intervals shorter than a broadcast program time span.

21. (Previously Presented) The method recited in Claim 16 wherein said on-site media service data enables said on-site media system to record a portion of said media signal on said dedicated portion of said hard disk according to subscription information.

22. (Previously Presented) The method recited in Claim 16 wherein said on-site media system is enabled by the off-site broadcaster to record said media signal on a continual basis at said on-site media system to provide up-to-date media.

23. (Original) The method recited in Claim 16 wherein said on-site media services data includes management information for said on-site media system.

24. (Previously Presented) The method recited in Claim 23 wherein said management information instructs said on-site media system how to manage said portion of said media signal recorded on said dedicated portion of said hard disk.

25. (Original) The method recited in Claim 16 wherein said on-site service data includes presentation information.

26. (Previously Presented) The method recited in Claim 25 wherein said presentation information enables said on-site media system to arrange said portion of said media signal recorded onto said dedicated portion of said hard disk into a presentation format.

27. (Original) The method recited in Claim 16 wherein said on-site media service data includes information for retrieving data from an Internet site.

28. (Original) The method recited in Claim 16 wherein said on-site media service data provides software updates.

29. (Original) The method recited in Claim 16 wherein said on-site media service data includes function information that enhances functionality of said on-site media system.

30-40. (Canceled)

41. (Previously Presented) The method of claim 16, wherein the off-site broadcaster is an over-the-air broadcaster.

42. (Previously Presented) The method of claim 16, wherein the dedicated portion of the hard disk is dedicated for the off-site broadcaster.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.